

REMARKS

Claims 1-23 are pending in this application. In the Office Action mailed September 10, 2007, the Examiner rejected claims 1-23. Applicant respectfully traverses the rejections and requests reconsideration based on the following remarks.

In addition, Applicant does not necessarily agree with or acquiesce to the Examiner's characterization of the claims or the prior art, even if those characterizations are not addressed herein.

Claim Rejections under 35 USC § 112

The Examiner rejected claims 9 and 14 under 35 U.S.C. § 112, second paragraph, by alleging that these claims fail to particularly point out and distinctly claim the subject matter at issue. Applicant respectfully traverses the rejection.

Specifically, the Examiner relied on MPEP § 2111.04 to reject the term "capable of" as being indefinite, but this section of the MPEP refers to whether certain terms limit the claim scope. MPEP § 2111.04 does not seem relevant to the Examiner's rejection because this section does not contemplate the interpretation of "capable of" and does not provide any guidance for rejecting the claims under 35 U.S.C. § 112 for using "capable of" in a claim.

Actually MPEP § 2173.05(g) refers to the term "capable of" and appears more relevant than the cited portion of the MPEP. According to MPEP § 2173.05(g),

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). ...

Whether or not the functional limitation complies with 35 U.S.C. [§] 112, second paragraph, is a different issue from whether the limitation is properly supported under 35 U.S.C. [§] 112, first paragraph, or is distinguished over the prior art. A few examples are set forth below to illustrate situations where the issue of whether a functional limitation complies with 35 U.S.C. [§] 112, second paragraph, was considered.

It was held that the limitation used to define a radical on a chemical compound as “incapable of forming a dye with said oxidizing developing agent” although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as “members adapted to be positioned” and “portions . . . being resiliently dilatable whereby said housing may be slidably positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

MPEP § 2173.05(g) (emphasis added).

In other words, the MPEP provides support that functional terms, such as “capable of,” are appropriate for defining the functionality of an apparatus. In this case, claim 9 recites “a circuitry capable of: monitoring ...; correlating ...; and for at least one of the parts of the application, correlating” Claim 14 recites language similar to that of claim 9. Applicant respectfully submits that these steps limit the structure to circuitry that performs these steps, thereby defining the metes and bounds of claims 9 and 14. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

Further, Applicant respectfully submits that the Examiner has only provided a conclusory statement without providing any reasoning as to why the term “capable of” fails to define the metes and bounds of the claim. If the Examiner disagrees with the remarks above, Applicant respectfully requests that the Examiner provide further

reasoning as to why the term “capable of” is inappropriate under 35 U.S.C. § 112, second paragraph.

Claim Rejections under 35 USC § 103

The Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2004/0128663 (“Rotem”) in view of U.S. Patent No. 5,732,215 (“Boutaghou”). Applicant respectfully traverses the rejection.

Rotem qualifies as only a 102(e) reference because the present application was filed on March 31, 2004, before Rotem’s publication date of July 1, 2004. However, according to 35 U.S.C. § 103(c), Rotem can be disqualified as prior art against this application if Rotem and the present application were commonly owned at the time the claimed invention was made.

Application 10/815,567 (the present application) and Rotem were, at the time the invention of the present application was made, both owned by Intel Corporation. According to MPEP § 706.02(l)(2), this statement should be sufficient evidence to disqualify Rotem from precluding patentability of the claimed subject matter of the present application.

Further, Applicant attaches herewith a Patent Assignment Abstract of Titles (“Assignment Abstract”) for Rotem and an Assignment Abstract for the present application (U.S. Publication No. 2005/0223250). According to the Rotem Assignment Abstract, Rotem was owned by Intel Corporation from at least the recorded assignment date of December 31, 2002. This date is prior to the present application’s filing date of

March 31, 2004. Applicant also provides the present application's Assignment Abstract to illustrate that the present application was previously owned by Intel Corporation.

Further, Applicant respectfully submits that, even if Rotem was prior art, one of ordinary skill in the art would not have a reason to combine Rotem in view of Boutaghou in the manner claimed.

For at least these reasons, Applicant respectfully submits that claims 1-23 are patentable over the cited prior art.

CONCLUSION


In view of the foregoing remarks, claims 1-23 are in condition for allowance. Accordingly, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Attachments:

Patent Assignment Abstract for U.S. Publication No. 2004/0128663 ("Rotem")
Patent Assignment Abstract for U.S. Publication No. 2005/0223250 ("present application")